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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,643	06/16/2005	Gerd Steiner	BASF.10039 (PF 54175)	2925
45473	7590	01/31/2006	EXAMINER	
HUTCHISON & MASON PLLC PO BOX 31686 RALEIGH, NC 27612			PRYOR, ALTON NATHANIEL	
			ART UNIT	PAPER NUMBER
			1616	
DATE MAILED: 01/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/539,643

**Applicant(s)**

STEINER ET AL.

**Examiner**

Alton N. Pryor

**Art Unit**

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/20/05</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10 and 11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant does not define "alkinyl". See definition of RbRc in line 2 of claims 10 and 11.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12,13,17,18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12,17 recites the limitation "aromatic groups" in definition of R1,R2 line 6 of claim 12. There is insufficient antecedent basis for this limitation in the claim.

Claims 13,18 recites the limitation "C1-C6 -haloalkyl", C1-C6-haloalkoxy" and "CC1-C6-haloalkylthio" in lines 2-3 of claim 13. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12-14,17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell et al (US 3444169; 5/13/69). Howell suggests 11-aminodibenz[1,4]oxazepines and 11-aminodibenz[1,4]thiazepines of the instant claims. See claim 1. Howell teaches that said azepines functions as tranquilizers. Howell suggests the azepine compound where X = O or S; R1 = R2 = alkyl; N(R) (CnH2nY) = 1-piperazino or 4-lower alkyl-1-piperazino (claim 1) which is instant compounds of formulae I-A and I-B having the O or S in seven membered ring; R1 = R2 = alkyl; Rz = H or alkyl; and o = 1. Howell teaches the addition of excipients (carriers) to compound prior to administration to a patient. See column 2 lines 28-45. Howell does not disclose the instant compound in an example. However, it would have been obvious to one having ordinary skill in the art to have made this compound. One would have been motivated to do this since compounds described in the rejection are structurally similar to Howell's compounds and therefore would have been expected to also function as tranquilizers.

Claims 12,13,17,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmutz et al (US 3539573; 11/10/70). Schmutz suggests an azepine compound where Z = S; R1 and R2 forms 1-piperaziny1 or 4-(lower alkyl)-1-piperaziny1; R3 = R4 =

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X, Alk, O-Alk, S-Alk which is equivalent to instant compound of formula I-A where position 11 bares a piperazinyll or 4-(lower alkyl)-piperazinyll; R1 and R2 = X, Alk, O-Alk, S-Alk; m=n=1; Rz = H or Alk; and o = 1. See column 1 lines 21-51. Schmutz teaches that said azepines functions as anti-depressants. See column 2 lines 13-16. Schmutz teaches the addition of excipients (carriers) to compound prior to administration to a patient. See column 13 lines 26-33. Schmutz does not disclose the instant compound described above in an example. However, it would have been obvious to one having ordinary skill in the art to have made this compound. One would have been motivated to do this since compounds described in the rejection are structurally similar to Schmutz's compounds and therefore would have been expected to also function as anti-depressants.

Claims 15,20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmutz et al (US 3539573; 11/10/70). Schmutz suggests the azepine compound where Z = lower alkyl imino; R1 and R2 forms 4-(lower alkyl)-1-piperazinyll; R3 = R4 = X, Alk, O-Alk, S-Alk which is equivalent to instant compound of formula I-C where position 11 bares a 4-(lower alkyl)-piperazinyll; R1 and R2 = X, Alk, O-Alk, S-Alk (both R1 and R2 not being X); m=n=1; Rz = Alk; and o = 1. See column 1 lines 21-51. Schmutz teaches that said azepines functions as anti-depressants. See column 2 lines 13-16. Schmutz teaches the addition of excipients (carriers) to compound prior to administration to a patient. See column 13 lines 26-33. Schmutz does not disclose the instant compound described above in an example. However, it would have been obvious to one having ordinary skill in the art to have made this compound. One would

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have been motivated to do this since compounds described in the rejection are structurally similar to Schmutz's compounds and therefore would have been expected to also function as anti-depressants.

Claims 16,21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmutz et al (US 3389139; 06/18/68). Schmutz suggests a morphanthridine compound where R = ethylene; R1 = H or Alk; R2 = H; R3 = R4 = Alk which is equivalent to instant compound of formula I-D where position 6 bares a piperazinyI or 4-(lower alkyl)-piperazinyI; R1 and R2 = X, Alk; RbRc = H; m=n=1; Rz = H or Alk; and o = 1. See column 1 lines 14-38. Schmutz teaches that said morphanthridine functions as anti-depressants. See column 1 lines 39-43. Schmutz teaches the addition of excipients (carriers) to compound prior to administration to a patient. See column 5 lines 5-15. Schmutz does not disclose the instant compound described above in an example. However, it would have been obvious to one having ordinary skill in the art to have made this compound. One would have been motivated to do this since compounds described in the rejection are structurally similar to Schmutz's compounds and therefore would have been expected to also function as anti-depressants.

Note in all above rejections X = halogen.

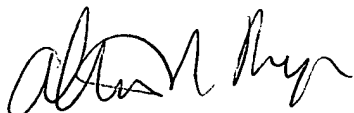
### ***Telephonic Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Alton Pryor', is positioned above the printed name.

Alton Pryor  
Primary Examiner  
AU 1616